



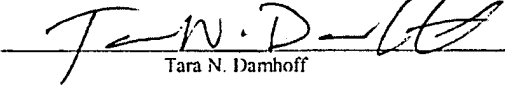
| | | | |
|--|---|--|----------------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 020375-045100US | |
| I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office MAIL STOP: AF on November 13, 2008. TOWNSEND and TOWNSEND and CREW LLP By:  Tara N. Damhoff | Application Number 10/731,294 | | Filed December 9, 2003 |
| | First Named Inventor Lisa C. Tidwell et al. | | |
| | Art Unit 3627 | Examiner Ramsey, Refai | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; margin-top: 20px;"> <div style="width: 45%;"> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 54,544</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 45%; text-align: center;">  Signature Tadd F. Wilson Typed or printed name 303-571-4000 Telephone number November 13, 2008 Date </div> </div> <p style="font-size: small; margin-top: 10px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |

☐ *Total of _____ form is submitted.

I hereby certify that this correspondence is being filed via
EFS-Web with the United States Patent and Trademark Office
MAIL STOP: AF on November 13, 2008

PATENT
Attorney Docket No.: 020375-045100US

TOWNSEND and TOWNSEND and CREW LLP

By: 
Tara N. Damhoff

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Lisa C. Tidwell et al.

Application No.: 10/731,294

Filed: December 9, 2003

For: SYSTEMS AND METHODS FOR
OBTAINING PAYOR INFORMATION
AT A POINT OF SALE

Customer No.: 20350

Confirmation No.: 3652

Examiner: Ramsey, Refai

Technology Center/Art Unit: 3627

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejections dated October 20, 2008 (the "Office Action") for the above-identified application. A response after-final has been filed in this application, but no amendments were made in that response, and none have been entered after-final. An Advisory Action was later issued on the above-identified application on October 27, 2008 (the "Advisory Action"). No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Reasons for Appeal:

Whether a prima facie case of obviousness is asserted by the Examiner when the cited art fails to teach the claim limitations:

The Examiner admits that at least three different claim elements are missing from the cited reference. First, the Examiner admits that “Brodie fails to explicitly teach that the check is a *payroll check* and that the *location information about an employer who has issued a payroll check is obtained and used for risk assessment.*” *Office Action*, p. 2 (*emphasis in the original*). As such, the Examiner admits that Brodie does not satisfy the requirements for obviousness as stated above.

Brodie cannot substantiate a case of obviousness alone when there are missing elements. As such, the Examiner now argues that “the use of payroll checks is notoriously well known in the art as well as the cashing of payroll checks.” *Office Action*, p. 2. The Examiner further states that “It is further well known that issuer information such as address information is printed on checks.” *Office Action*, p. 2. The Examiner has failed to provide any basis either by Official Notice, inherency, or other reasoning to justify that the missing elements are somehow disclosed in Brodie or well known.

The Examiner goes on to state in the Office Action that “it would have been obvious to one of ordinary skill in the art to modify Brodie et al.’s system to include this feature because doing so would allow for Brodie et al.’s system to cash payroll checks by verifying that the issuer of the check (employer) is a local company.” *Office Action*, p. 3. There are numerous problems with both the recitation of elements as being well known and the proffer of the motivation.

Second, the Examiner states that the claim element, “request location information about an employer who has issued a payroll check,” is missing from Brodie. “[Brodie et al.] fail to teach . . . that the location information about an employer who has issued a payroll check is obtained . . .” *Office Action*, p. 4. The Examiner only states that it would have been obvious to include this feature into Brodie to verify that an issuer of a check is a local company. As such, claim 1 is allowable over Brodie for at least this reason.

Finally, the Examiner again states that the claim element, “obtain from the keypad the employer location information and to transmit the employer location information to a remote location,” is not shown in Brodie. “[Brodie et al.] fail to teach . . . that the location information about an employer who has issued a payroll check is obtained . . .” *Office Action*, p. 4. The Examiner only states that it would have been obvious to include this feature into Brodie to verify that an issuer of a check is a local company: As such, claim 1 is allowable over Brodie for at least this reason.

Whether the cited art inherently teaches the claim elements without the proper justification from the Examiner:

It is not inherent that Brodie teaches the missing element of the claims. MPEP § 2112 states that “‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) . . .”. If Brodie were to inherently describe the elements of claim 1, it would be apparent that Brodie would use location data to determine risk. Rather, Brodie authenticates the check casher. *See Brodie*, col. 7, line 7 – col. 9, line 63 and Fig. 2. Then, Brodie authenticates the check. *See Brodie*, col. 9, line 64 – col. 11, line 58, and Fig. 3. There is no mention of requesting location information or using location information to determine risk. Indeed, Brodie relies only on authenticating the person and the check – and determining risk by the location of the check issuer. As such, Brodie cannot inherently anticipate the claims just because Brodie describes check data.

Whether the Examiner properly asserted Official Notice without providing any justification for the finding:

The claim terms are also not well known. Any attempt at taking Official Notice must fail. The Examiner has not purported to take Official Notice, which violates the notice requirements in M.P.E.P. § 2144.03. However, Applicants respectfully traverse the possibility of Official Notice taken in the Final Office Action by the Examiner. Applicants submit that the Examiner, according to M.P.E.P. § 2144.03, has improperly taken Official Notice. Specifically, M.P.E.P. § 2144.03 states: “In certain circumstances where appropriate, an examiner may take Official Notice of facts not in the record or rely on “common knowledge” in making a rejection,

however *such rejections should be judiciously applied.* (*Emphasis added*). Applicants believe that the taking of Official Notice for the elements of claims fails to meet this standard.

According to the M.P.E.P. § 2144.03, to properly take Official Notice, the Examiner must meet four criteria before invoking the applicant's duty to respond. First, the information for which the Examiner is taking Official Notice must be the proper type of information, that is, the fact noticed is readily verifiable. Second, the Examiner must present the applicant with explicit basis on which the examiner regards the matter as subject to Official Notice. This basis must include some reasoning as to why the material is readily verifiable. Third, the other references of record must support the notified fact. Fourth, nothing of record contradicts the notified fact.

With regard to the first element, the material (e.g., that check cashing devices request and send issuer location information to a remote location and the issuer location is used in risk analysis) is not appropriate for a finding of Official Notice. It is not common sense that such issuer location information would be used in this manner. Further, it cannot be readily verifiable as other natural phenomena are. For example, it is readily verifiable that the sun rose at 6:44 a.m. on September 14, 2008. Applicants are not aware of and were not presented with any way to determine that the noticed fact is readily verifiable. The Examiner did not indicate where or how Applicants could verify the noticed fact.

With regard to the second element, the Examiner's basis for employing issuer location information in risk analysis is not well known. The Examiner has not presented any other references to support the taking of Official Notice. Indeed, all the Examiner states is that "It is well known that issuer information such as address information is printed on checks." *Office Action*, p. 2. The Examiner never explains why this is well known and makes no mention of why using the issuer information for risk analysis is well known.

With regard to the third element, Applicants believe that the record does in fact contradict the taking of Official Notice. The very art cited by the Examiner makes no mention of location information. Indeed, Brodie states that "the check data includes one or more data fields (e.g., legal amount, courtesy amount, payee, signature, endorsement, date and check type)." Brodie, col. 2, lines 8-21. The Examiner attempts to equate "check data" with location information. However, nowhere in the entire disclosure of Brodie is there mention of the

employer's location being part of the check data. Brodie actually states "The imaging software, administered by the host, server, check-cashing administrative entity, or another administrative entity, reviews the key fields on each submitted check, including, but not limited to, legal amount, courtesy amount, payee, signature line, endorsement, date and check type." Brodie, col. 10, lines 52-57. Brodie says nothing about issuer location information being requested or input. Thus, the record defies the Examiner's contention that using issuer location information for risk analysis is well known.

Lastly, with regard to the fourth element, Applicants submit that the Office Action does contradict the Examiner's contention. As shown, Brodie, the cited art, makes no mention of issuer location information. Furthermore, in a search of the USPTO database for issued patents using the search string "SPEC/((risk AND cashing) AND (check AND "issuer location"))," the only two patents that were found were U.S. Patent No. 7,398,925 and 7,287,629, which are both related to the present application. Thus, there appears to be little support in the prior art for the Examiner's contention that requesting location information is well known.

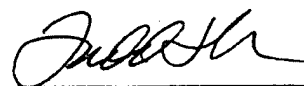
Accordingly, Applicants respectfully request that the Examiner must support all findings with adequate evidence as required by M.P.E.P. section 2144.03(c), or that the Official Notice be withdrawn and the claims allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
T3W:cmb
61690422 v1



Tadd F. Wilson
Reg. No. 54,544